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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,235	08/21/2003	Mahmoud F. Abdelgany	SPINE 3.0-298 DIV I	7163

530 7590 01/30/2007  
LERNER, DAVID, LITTENBERG,  
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600 SOUTH AVENUE WEST  
WESTFIELD, NJ 07090

EXAMINER
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REIMERS, ANNETTE R

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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**Office Action Summary**

Application No.

10/645,235

Applicant(s)

ABDELGANY ET AL.

Examiner

Annette R. Reimers

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 11-40 and 42 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7, 16, 18, 19, 25 and 30-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11-15, 17, 20-24, 26-29, 33-40 and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant is reminded of the election with traverse of Species a, figure 1, in the reply filed on June 19, 2006. Thus, claims 6, 7, 16, 18, 19, 25 and 30-32 were withdrawn from the previous office action and are still withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 19, 2006.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 11-15, 17, 20-24, 26-29, 33-37, 39, 40 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Duvillier et al. (US Patent Number 5,749,876).

Duvillier et al. disclose various embodiments of a bone graft forming guide for providing a bone graft having a desired shape comprising a main body, 14, 21 and 24 (block), with a guide receiving opening, 19, and protrusions, e.g. 16 and 39, a holder, 28, an insertable hole guide, 46, containing a plurality of linear hole guides, 49, arranged in a pattern generally corresponding to the desired shape of the bone graft, and an insertable cutting guide, 30, containing slots, 31, hinged portions at 37 on 24

Art Unit: 3733

and 19 on 14 and a clamping mechanism, 61 (see various embodiments in figures 2 and 3). Regarding claim 11, the body includes a first member, e.g. 21 and a second member, e.g. 24, pivotally connected to one another (see figure 2 and column 7, lines 40-65).

It is noted that the preamble of claims 1 and 5 recites. "A bone graft forming guide for providing a bone graft having a desired shape" and the preamble of claims 11, 27 and 42 recites "An instrument for use in forming a bone from bone graft material", both of which amount to an intended use recitation. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Furthermore, with regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Duvillier et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Moreover, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Duvillier et al. (US Patent Number 5,749,876).

Duvillier et al. disclose the claimed invention except the outline being arcuate. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the device of Duvillier et al. having an arcuate outline, since it is just one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of providing various shaped bone grafts. In re Dailey and Eilers, 149 USPQ 47 (1966).

***Response to Arguments***

Applicant's arguments filed on November 7, 2006 have been fully considered, but they are not persuasive. Examiner respectfully disagrees with applicant regarding the Duvillier et al. reference. The hole guide, 46, of Duvillier et al. contains a plurality of holes guides, 49, arranged in a pattern generally corresponding to the desired shape of the bone graft. The hole guides, 49, can provide a roughened or irregular surface on the bone graft. Furthermore, the hole guide 46 and the cutting guide 30 have a similarly shaped pattern, e.g. a linear pattern, for forming a bone graft. Moreover, according to

Art Unit: 3733

applicant's specification, "a wide variety of patterns can be provided in the hole guide and cutting guide to provide various shaped bone graft." (see paragraph 0036). Regarding claim 11, the body includes a first member, e.g. 21 and a second member, e.g. 24, pivotally connected to one another (see figure 2 and column 7, lines 40-65).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

Art Unit: 3733

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER